



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Joachim KRALIK ET AL.

Examiner: Cutliff

Serial No.: 10/525,821

Group Art Unit: 1609

Filed: 25 February 2005

Title: PROCESS FOR THE ENANTIOSELECTIVE HYDROGENATION OF AMINO ALCOHOLS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant elects, with traverse, Group II, claims 1- 14 drawn to the process for preparation of amino alcohol, claim 5 (in part) and not covered by Group I, wherein:

- R1, is a heterocyclic radical such as 2-thienyl, as defined in claim 2,
- R2 is a methyl as defined in claim 3,
- n is 1 as defined by claim 4 and
- the catalyst of formula A is a transition-metal complex containing rhodium or salts thereof as defined in claim 7.

Applicants respectfully urge that the full scope of the claims have unity of invention and should not be subject to restriction. All of the claims depend ultimately from claim 1 and all of the claims share the special technical features of formula I, formula II, and catalyst A.

Furthermore, all the claims in the application share a special technical feature, e.g., a

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to:
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Name:

Jeanette Kronig

Signature:

Jeanette Kronig

process for the preparation of amino alcohols according to formula I by enantioselective hydrogenation of amino ketones of the formula II in the presence of a catalyst of formula A. A search would therefore comprise overlapping subject matter, and it would not be an undue burden on the examiner to carry out a search. "If search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct invention." (Emphasis added.) M.P.E.P. 803. Accordingly, withdrawal of the restriction is respectfully requested.

Election of Species

Applicant elects, species A: the transition-metal complexed to a chiral diphosphine ligand according to formula A of claims 1, 6 and 7 used in the processes of Groups I-VII, and as defined to contain individually specific functional groups with respect to R⁵ through R¹², m, and R⁵, R⁶ and R⁷ as defined and/or defined as B which contains individually specific functional groups Y, Z, Q in claim 1.

Applicants further note that M.P.E.P. Section 803.02 of the M.P.E.P. states that following election of a portion of a Markush claim, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. The M.P.E.P. states that should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is found that anticipates or renders obvious the Markush-type claim with respect to a non-elected species, the Markush-type claim shall be rejected.... [Emphasis added.] M.P.E.P. § 803.02. Thus, should this species be allowable, expansion of the search and examination is appropriate.

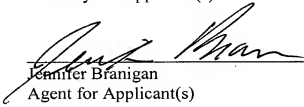
For all of the above reasons, it is urged that the restriction requirement should be withdrawn. Favorable action is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

No fee is believed to be due with this response, however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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Attorney Docket No.: **Merck-2978**

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